

## **REMARKS:**

### **Status Of Claims**

Claims 1-8, 13, 14, and 30-46 were previously pending. Claims 1 and 13 have been amended. Claim 2 has been canceled. Thus, claims 1, 3-8, 13, 14, and 30-46 are currently pending in the application with claims 1, 31, and 40 being independent.

### **Office Action**

In the Office Action, the Examiner objected to the specification. The specification has been amended as suggested by the Examiner.

The Examiner rejected claims 40-46 under 35 U.S.C § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that “[n]o securing mechanism’ is not enabled”. Page 3 of the March 9, 2007 Office Action. However, page 25, lines 3-13, of the specification states:

The carrying case 178i is preferably approximately twelve inches long, six inches wide, and two inches high, although the length may range between six inches and eighteen inches, the width may range between two inches and ten inches, and the height may range between one-half inch and four inches. ***The case 178i is preferably sized to fit within the tray 14i such that no securing mechanism is needed to secure the case 178i within the tray 14i.*** Alternatively, the tray 14i and case 178i may be provided with mating VELCRO, magnets, or other securing mechanism that provides for easy and quick installation and removal of the case 178i from the tray 14i. The case 178i is preferably made of hard plastic to protect the navigational device 10i housed within the case 178i, and the case 178i may include a gasket to seal the case 178i from any liquids, such as rainwater. (emphasis added)

Figures 20 and 21 show the case 178i configured to fit within, or conforming to, the tray 14i “such that no securing mechanism is needed to secure the case within the tray”, as claimed. Since the claim limitation is both described in the specification and shown in the figures, the limitation is fully enabled. Thus, no correction appears to be required.

The Examiner also rejected claims 2-8, 13, 31-39, and 41-46 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that “‘originally installed during the manufacture of the vehicle’ is indefinite”. Page 3 of the March 9, 2007 Office Action. However, the paragraph beginning on page 24, line 21, and continuing through page 25, line 2, of the specification states:

The tray 14i is preferably formed during manufacture of the vehicle and is positioned in the dashboard 88i of the vehicle, as illustrated in Fig. 20. The tray 14i may be provided in the vehicle for holding objects such as coins, eyeglasses, or other miscellaneous articles. As illustrated in Fig. 21, the tray 14i may be retrofitted with a first set of electrical connections 180i to connect the navigational device 10i to a power source and data source, such as a speedometer, supplied by the vehicle. Further, the tray 14i may include connections for an external speaker, display, computer, etc. The tray 14i is normally installed during manufacture of the vehicle and is heat staked to the dashboard 88i of the vehicle. The tray 14i may easily be removed from the dashboard 88i after manufacture of the vehicle, and the first set of electrical connections 180i may then be installed in the tray 14i without affecting the aesthetics of the tray 14i. Alternatively, the tray 14i may be removed and replaced with another tray already provided with the electrical connections 180i.

In other words, the limitation is directed to a tray installed during vehicle manufacturing, rather than trays that may be installed thereafter, such as by a consumer. Thus, no correction to claims 2, 31, and 42 appears to be required. Claim 13 has been amended to depend from claim 7, thereby removing any potential conflict with claim 8.

The Examiner also rejected claims 1-8, 13, 14, and 30-46 under 35 U.S.C. 102(b) as being anticipated by Toshiaki, Japanese Patent No. 9224202. The Examiner also rejected claims 1-4, 14, 31-33, and 38 under 35 U.S.C. § 102(b) as being anticipated by Schoenfish, U.S. Patent No. 6,370,037. The Examiner also rejected claims 41, 42, 45, and 46 under 35 U.S.C. § 102(b) as being anticipated by Amazon.com's advertisement of a Garmin carrying case. The Examiner also rejected claims 43-46 under 35 U.S.C. § 103(a) as being unpatentable over the Amazon.com advertisement in view of official notice. The Examiner also rejected claims 5-8, 13, 30, 34-37, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Schoenfish in view of Trumbull, U.S. Patent No. 6,125,030. Applicant respectfully submits that the currently pending claims distinguish the present invention from Toshiaki, Schoenfish, the Amazon.com advertisement, Trumbull, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 recites "a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to conform to the tray, **wherein the tray is originally installed in the vehicle during manufacture of the vehicle**", emphasis added. Claim 31 recites "a carrying case sized and configured to conform to a tray of the vehicle, **wherein the tray is originally installed in the vehicle during manufacture of the vehicle**, wherein the carrying case may be removed from the tray with the navigational device substantially enclosed therein", emphasis added.

With regard to the Tshiaki reference, the Examiner merely asserts that these claims are “clearly anticipated by Toshiaki”, but does not support that assertion in any way. Page 4 of the March 9, 2006 Office Action. Such conclusory rejections are improper. Each “ground of rejection [must be] fully and clearly stated”. MPEP § 707.07(d). *See also* 37 CFR 1.104.

In any case, neither Toshiaki nor Schoenfish teach or suggest “wherein the tray is originally installed in the vehicle during manufacture of the vehicle”, as claimed. With regard to claim 31, the Examiner asserts that “[t]his language does not structurally limit the claimed invention”. Page 5 of the March 9, 2007 Office Action. Applicant disagrees. Furthermore, the Examiner may not simply “prosecute the claims under the assumption that the above claim language adds no structure limitation to the” claims, as suggested on page 4 of the March 9, 2007 Office Action. The Examiner cites no support for such examination and Applicant finds none. Rather, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As discussed above, this language is described in the specification. Specifically, trays, such as that claimed, “may be provided in the vehicle for holding objects such as coins, eyeglasses, or other miscellaneous articles.” Page 24, lines 22-24, of the specification. Furthermore, this feature allows the present invention to be used with vehicles not originally equipped with navigation devices and without modifications, by taking advantage of a tray originally installed in the vehicle during manufacture of the

vehicle. Thus, this language constitutes a claim limitation. Since the Examiner does not even assert that the cited prior art teaches this limitation, the present rejections cannot be sustained.

Claim 40 recites “a carrying case configured to substantially enclose the navigational device, the case being sized and configured to fit within a tray on a dashboard of the vehicle such that no securing mechanism is needed to secure the case within the tray”.

With regard to the Toshiaki reference, as discussed above, the Examiner improperly asserts that these claims are “clearly anticipated by Toshiaki”, but does not support that assertion in any way. As this is the only ground of rejection for claim 40, the Examiner has failed to establish a *prima facie* case of anticipation with regard to claim 40.

In any case, Applicant is unable to find any reference in Toshiaki to a navigation device, much less a “case being sized and configured to fit within a tray on a dashboard of the vehicle such that no securing mechanism is needed to secure the case within the tray”, as claimed. As a result, the present rejection cannot be sustained.

The remaining claims all depend directly or indirectly on claims 1, 31, or 40, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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